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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,539	08/17/2001	Gavin J. McIntosh	FMCE-P064	3957
7590	12/15/2004		EXAMINER	
Henry C. Query, Jr. 504 S. Pierce Ave. Wheaton, IL 60187			HALFORD, BRIAN D	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/932,539	MCINTOSH, GAVIN J.
	Examiner Brian D Halford	Art Unit 3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 August 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

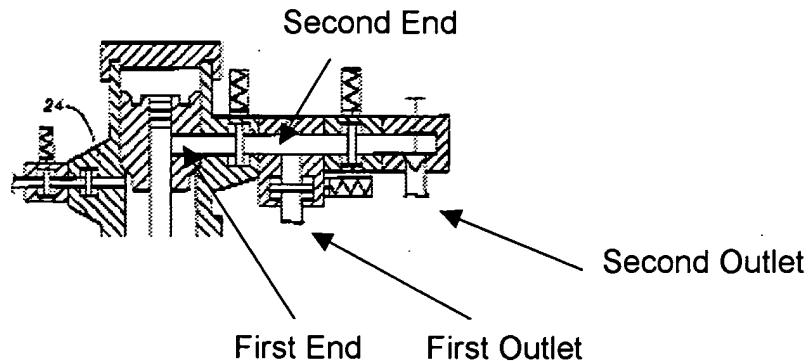
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 6-8, 10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Hopper *et al.* With particular reference to drawing Figure 3A combined with lines 51-67 and 1-7 of respective columns 4 and 5, Hopper *et al.* disclose, *inter alia*, a horizontal christmas tree (24) with vertical completion tubing *or* production bore (21) landed therein for production. As clearly shown by the illustration, the vertical completion tubing *or* production bore (21) is connected to a horizontal production bore, which contains two production outlets; moreover, drawing Figure 3A clearly depicts respective valve members on each of the two production outlets. Regardless, production of oil via tubing necessitates various types of valve members. The Examiner has provided Applicant with a facsimile of Hopper *et al.*'s drawing Figure 3A for convenience. Additionally, the Examiner has provided elucidating arrows on the figure

noted *supra* that indicate the first and second ends of the horizontal bore as specifically called for in Applicant's recently amended claim 1.

Fig. 3A



In accordance with the requisite reading of a claim as broadly as possibly, Applicant's attention is drawn to the a definition of the word, "end" as found in MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 10TH EDITION.

end \ 'end \ n : 2a : cessation of a course of action, pursuit or activity.

Thus, the production from the first end to the second follows a particular course of action; however, the particular course of action is disrupted upon reaching the second end—the course of action clearly changes as shown in the drawing figure.

3. Claims 8, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Weston ('807). With particular reference to Figure 10 in concert with lines 47-63, 15-18 and 9-16 of respective columns 2, 7 and 14; Weston discloses a horizontal christmas tree and teaches its attendant advantages over a conventional vertical tree. As clearly

depicted in the drawing, the tree possesses, *inter alia*, two production outlets. As clearly stated in lines 9-16 of column 14, production is realized via wing valves (310, 312).

4. Claims 8, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hynes *et al.* With particular reference to Figure 8 in concert with lines 44-44, 45-48 and 11-25 of respective columns 2, 5 and 9; Hynes *et al.* disclose a horizontal christmas tree and teaches its attendant advantages over a conventional vertical tree. As clearly depicted in the drawing, the tree possesses, *inter alia*, two production outlets (108, 109). As clearly stated in lines 11-25 of column 9, production is achieved via respective control valves (200, 201).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2, 4-5, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooper *et al.* The disclosure of patent to Hooper *et al.* has been discussed *supra*. Hooper *et al.* fail to disclose the claimed outlet diameters; however, the sizing of an outlet is a design choice that is a function of myriad variables. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the outlets of Hooper *et al.* to the claimed diameters as

specifically called for in Applicant's claims 2, 4-5, 9, 11 and 12, since it has held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges merely involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 2, 4-5, 9, 11 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Weston ('807). The disclosure of patent to Weston has been discussed *supra*. Weston fails to disclose the claimed outlet diameters; however, the sizing of an outlet is a design choice that is a function of myriad variables. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the outlets of Weston to the claimed diameters as specifically called for in Applicant's claims 2, 4-5, 9, 11 and 12, since it has held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges merely involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

8. Claims 2, 4-5, 9, 11 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Hynes *et al.* The disclosure of patent to Hynes *et al.* has been discussed *supra*. Hynes *et al.* fail to disclose the claimed outlet diameters; however, the sizing of an outlet is a design choice that is a function of myriad variables. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the outlets of Hynes *et al.* to the claimed diameters as specifically called for in Applicant's claims 2, 4-5, 9, 11 and 12, since it has held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges merely involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

9. Applicant's arguments filed 10 September 2004 have been fully considered but they are not persuasive.

Regarding Hopper *et al.*, applicant notes in lines 2-3 of page 2 that Hopper does not disclose the function of the various conduits depicted in Figure 3. Subsequently, applicant alleges in the third paragraph of page three that tree (24) contains a singular production outlet. Specifically, applicant contends that examiner-labeled "Second Outlet" is the only production outlet in the tree (24) of Hopper. Furthermore, applicant maintains that examiner labeled "First Outlet" is a crossover line as opposed to a production outlet. The Examiner respectfully submits that it is known in the art to employ a crossover line as a production outlet. The patents to Mohn, Gould, Townsend, Jr., the patent application to DeBerry and the Foreign Search Report to Doyle *et al.* teach crossover lines as production outlets in horizontal trees. As an example, DeBerry depicts "Production crossover flow" in Figure A6 and teaches the same in the accompanying literature. With reference to paragraph [0031], production fluid flows up production tubing (22) and enters a crossover line (84) for recovery. Additionally, applicant is reminded if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding Weston ('807), applicant argues that Figure 10 is not a horizontal tree. Applicant suggests in the final paragraph of page three in addition to lines 1-2 of page four that the Examiner cannot conclude Figure 10 is a horizontal tree from Weston's

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brief description of the "horizontal tree embodiment" of Figure 10. The Examiner respectfully disagrees with applicant since Weston clearly states in line 16 of column 7 that Figure 10 is a horizontal tree. Regardless, Applicant admits on line 5 of page 4 that the housing may be considered a tree. However, applicant argues that the tree of Weston is not a horizontal tree since a tubing hanger is not landed in the tree body. Applicant supports the argument by referencing applicant's amendment filed on February 11, 2004, which features a prior art exhibit of horizontal trees. With reference to the exhibit, applicant maintains that horizontal trees, as generally understood by one of ordinary skill in the art, feature a vertical bore for receiving a tubing hanger. The noted exhibit is not persuasive because horizontal trees do not necessarily possess an area for receipt of the tubing hanger. This is shown in the prior art cited in this instant office action. Furthermore, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). In the instant case, applicant's specification is completely silent with regard to tubing hangers. Finally, applicant is reminded if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding Hynes, applicant argues that Figure 8 is not a horizontal tree. The Examiner respectfully disagrees with applicant since Hynes clearly states in line 46 of column 5 that Figure 8 is a horizontal tree. Regardless, Applicant admits on line 22 of page 4 that the housing may be considered a tree. However, applicant argues that the tree of Hynes is not a horizontal tree since a tubing hanger is not landed in the tree

body. Applicant supports the argument by referencing applicant's amendment filed on February 11, 2004, which features a prior art exhibit of horizontal trees. With reference to the exhibit, applicant maintains that horizontal trees, as generally understood by one of ordinary skill in the art, feature a vertical bore for receiving a tubing hanger. The noted exhibit is not persuasive because horizontal trees do not necessarily possess an area for receipt of the tubing hanger. This is shown in the prior art cited in this instant office action. Furthermore, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). In the instant case, applicant's specification is completely silent with regard to tubing hangers. Finally, applicant is reminded if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Halford whose telephone number is (703) 306-0556. The examiner can normally be reached on M-F 10:30-8:00; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

bdh *bdh*

December 9, 2004